

REMARKS

Claims 1-29 and 31-44 remain pending in the current Application. Claims 41-44 have been amended. Applicants submit that the amendments do not add new matter to the current Application. All the amendments herein have been made in order to clarify the claims and not for prior art reasons. Applicants also submit that (1) no amendment made was related to the statutory requirements of patentability unless expressly stated herein, and (2) no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Claim Objections – 37 CFR § 1.75

The Examiner rejected claim 43 as containing an informality. Applicants note that the informality noted by the Examiner is in a limitation of claim 42, not claim 43, as listed in the Office Action.. Accordingly, Applicants have amended claim 42 to correct the informality. Applicants, therefore, respectfully request that the Examiner withdraw this objection in the next Office Communication.

Rejection of Claims 41-44 under 35 U.S.C. 101

The Examiner rejected claims 41-44, but has indicated that these claims would be allowable if written as computer programs that include a plurality of instructions. Therefore, in order to further prosecution, Applicants have amended the preamble of claims 41-44 to refer to a computer program and instructions that are executable on a computer. Therefore, Applicants submit that claims 41-44, as amended, are patentable under 35 U.S.C. 101.

Rejection of Claims – 35 U.S.C. 102

Claims 1-29 and 31-44 stand rejected under § 102(a) as being anticipated by a paper published in 1999 by Sirichotiyakul et al. entitled "Stand-by power minimization through simultaneous threshold voltage selection and circuit sizing" (hereinafter "the paper"). Applicants note that the paper was written by six of the Applicants, with Jingyan Zuo being listed as an author but, as declared by Applicants, was an engineering student and not an inventor. Applicants respectfully traverse the rejections.

Applicants disagree with the Examiner's contention that Applicants' declaration under 37 CFR § 1.132 is insufficient to overcome the rejection of the claims. Applicants note that the list of inventors includes two individuals that are not listed as authors of the paper (Judah Adelman and David Moshe). However, Applicants note that the paper and Applicants' disclosure in the specification, while similar, are not nearly identical. Applicants' undersigned representative discussed the 1.132 declaration with the Examiner. Applicants' representative pointed out that either one of two situations likely arose. First, the contributions made by Adelman and Moshe were not included in the paper because their patentable contributions, while in the patent application, were not disclosed in the paper. Second, the paper lists only those people that authored the paper. To the extent, if any, that patentable contributions of Adelman and Moshe are included in the paper, it appears likely that such contributions were passed along to one of the other Applicant/Authors for inclusion in the paper.

As explained by Applicants' undersigned attorney in his discussions with the Examiner, at the time of the inventions each of the inventors worked for a common entity (Motorola, Inc.) with an obligation of assignment. Since the time that the instant Application was filed, (1) the Application was assigned to a new corporation, Freescale Semiconductor, Inc. (Freescale having formerly been a division of Motorola, Inc.), and (2) most of the inventors have left the company. Applicants' undersigned attorney could only find two inventors (Tim Edwards and Rajendran Panda) that are still employed with the assignee, Freescale Semiconductor, Inc. Because of the

foregoing, Applicants' attorney explained that a declaration or affidavit under 37 CFR 1.132 would be exceedingly difficult as the location of individual inventors is no longer readily ascertainable. Applicants' undersigned attorney believes that Adelman and Moshe reside in the country of Israel. If compelled, Applicants' attorney will undertake a search for the inventors in order to file a new declaration under 37 CFR § 1.132 that explains exactly why Adelman and Moshe are not listed as authors of the paper. However, such search should not be necessary in light of the declaration under 37 CFR § 1.131 included with this Response.

During discussions between Applicants' attorney and the Examiner, a declaration under 37 CFR § 1.131 was discussed in order to provide the Examiner with proof that the Applicants invented the subject invention prior to the publication of the paper in 1999. Applicants respectfully assert that Applicants completed and reduced to practice Applicants' claimed invention before the publication of the paper. A declaration, pursuant to 37 C.F.R. § 1.131, has been duly executed by Applicant Tim Edwards and is included with this Response. Mr. Edwards declares that Applicants' claimed invention was completed and reduced to practice prior to the publication of the paper (to which Mr. Edwards is an author). Exhibits "A" and "B" to Mr. Edwards' declaration are Invention Disclosure Forms that disclosed Applicants' claimed invention. These Disclosure Forms were submitted to the assignee's Intellectual Property Law Department in Austin, Texas prior to the publication date of the paper. Mr. Edwards' declaration under 37 C.F.R. § 1.131, therefore, removes the paper from consideration as prior art. Because, for the aforesaid reasons, the paper is not prior art with respect to Applicants' claimed invention, Applicants respectfully assert that Claims 1-29 and 31-44 are allowable under 35 U.S.C. § 102.

Applicants firmly believe that the Declaration of Mr. Edwards and the Exhibits thereto are more than sufficient to show that Applicants conceived of the claimed invention and reduced it to practice before the publication of the paper which was authored by six of the eight Applicants. If, for any reason, the Declaration of Mr. Edwards and the Exhibits thereto are insufficient to remove the paper as consideration as prior art, Applicants respectfully request a non-final office action to which Applicants can respond with a revised declaration under 37 CFR

§ 1.132 which adequately explains why Adelman and Moshe were not listed as authors of the paper.

Conclusion

Although Applicants may disagree with statements made by the Examiner in reference to the claims and the cited references, Applicants are not discussing all these statements in the current Office Action, yet reserve the right to address them at a later time if necessary.

Applicants respectfully solicit allowance of the pending claims. Please contact the undersigned attorney if there are any issues regarding this communication or the current Application.


If Applicant has overlooked any additional fees, or if any overpayment has been made, the Commissioner is hereby authorized to credit or debit Deposit Account 502117.

Respectfully submitted,

SEND CORRESPONDENCE TO:

Freescale Semiconductor, Inc.
Law Department
Customer Number: 23125

By:


Joseph T. Van Leeuwen
Reg. No.: 44,383
Telephone: (512) 996-6839
Fax No.: (512) 996-6854